

REMARKS

Claims 42-48 are pending in the present application. Claim 47 was amended. Claims 1-41 and 49-142 were withdrawn in a Restriction Requirement filed June 6, 2009. Reconsideration of the claims is respectfully requested.

In this Amendment, Applicant has amended claim 47 from further consideration in this application. Applicant is not conceding that the subject matter encompassed by claim 47 prior to this Amendment is not patentable over the art cited by the Examiner. Claim 47 was amended in this Amendment solely to facilitate expeditious prosecution. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by claim 47, as presented prior to this Amendment and additional claims in one or more continuing applications.

Amendments were made to the specification to correct errors and to clarify the specification. No new matter has been added by any of the amendments to the specification and claims.

I. Examiner Interview

Applicants thank Examiner Johnna Loftis for courtesies extended Applicants' representative on September 14, 2009. The discussion centered on claim 47. The Examiner expressed that she wished to apply a §112 rejection to claim 47 for reason of it being unclear, and in particular that the preamble recites a method for a property management message to relay... a service request from a service requestor to **a property manager**, however, the final element in claim 47 (step) states that relaying at least part of the service request from the service requester to the person (**a person other than a property manager**). Applicants' representative said that he would amend claim 47. No agreement was reached, as to the allowability of the remaining claims in the case.

II. 35 U.S.C. § 102 Anticipation

The Examiner has rejected claims 42 and 44-48 under 35 U.S.C. § 102(e) as being unpatentable over Ruben et al (U.S. Patent US 7,143,049, hereinafter "*Ruben*"). Applicants respectfully traverse.

Rule 102(e) reads:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

35 U.S.C. § 102(e) in effect for applications filed prior to November 29, 2000.

Claim 42 recites:

A computer-implemented method for a property management system to relay at least part of a service request from a service requestor to a property manager, comprising the steps of:

receiving a service request from a service requestor, the service request being transmitted to the property management system, the service request being associated with a property having a management affiliation;

identifying, with the property management system, a property manager by successively reviewing increasingly more general descriptions of the management affiliation of the property until a property manager is identified; and

relaying at least part of the service request from the service requestor to the property manager.

At the outset, Applicants, through the Declaration of Prior Invention under 37 C.F.R. § 1.131 assert that **their invention dates to prior to March 16, 2000** (See Declaration dated October 13, 2006). The declaration, in a timely fashion, couples conception of the invention to the provisional application date of August 23, 2000. Conception dating back to March has never been disputed. On the other hand, the *Ruben* non-provisional patent application was filed November 2, 2000, while the provisional application from which it relies, was filed July 28, 2000. Accordingly, the earliest file date for *Ruben* is July 28, 2000. Since the Applicants were in possession of their invention prior to the earliest filing date of the §102 reference, Applicants have successively antedated *Ruben*. Thus, for at least this reason, *Ruben* does not qualify as prior art. Accordingly, Applicants have overcome the rejection under 35 U.S.C. § 102.

Even if *Ruben* were prior art, Applicants respectfully urge that *Ruben* fails to teach every limitation of claim 42, arranged as they are in the claim. The Examiner alleges *Ruben* to teach the recited, “identifying, with the property management system...”. The Examiner alleges the following passages to teach this limitation:

IV. Service Module

Service Request. One of the features of the system is to enable certain authorized users of a property to initiate service requests to property owners or property managers using an Internet-based tool and a standard process. By integrating the Internet and wireless technology, the system facilitates the communication between the user at a property initiating a service request, on the one hand, such as a tenant, property owner or property manager, and, on the other hand, the vendor user(s) responsible for fulfilling the request. The system also enhances the overall experience associated with submitting a service request by providing point-in-time status on all service requests. Further, the system provides the property owner or property manager with the capability to associate costs and detail information to all service requests initiated and fulfilled within a property site.

A. Create or Update a Service Request. In using the system, there are various actions that initiate a service request, including any updates to existing service requests, the ability to view or print a service request, canceling an existing request and accessing completed/archived service requests. Preventative Maintenance requests (scheduled), include Ad Hoc service requests (requests created by the property engineering staff). Various types of service requests are shown in Table 4 below. In Table 4, a shared resource request is one that applies to a common service that can be used by all of the tenants of a building, like use of a freight elevator.

Ruben col. 12, lines 1-52.

1. Create a Service Request--an interactive document is displayed. The user making the request selects a type of service needed from a list similar to that above. A list of vendors that can perform the needed services is then displayed. **The vendor is selected and the request is made and transmitted to the vendor over the Internet.** The request indicates the dollar limit authorization of the person who made the request. The vendor can accept the request, reject it, or request modification. This can all be done via the Internet.

Ruben col. 13, lines 45-55.

As can be seen, *Ruben* fails to describe claim 42 recited, “successively reviewing increasingly more general descriptions of the management affiliation until a property manager is identified”. The Examiner offers, “a list of vendors that can perform the needed service is displayed – inherently general descriptions of the vendors are reviewed so only those who perform needed services are displayed” (office action dated August 20, 2009, p. 3).

Accordingly, by the Examiner’s assessment, general descriptions of the vendors are reviewed. However, merely reviewing general descriptions falls short of the claim limitations. Claim 42 recites, “successively reviewing **increasingly more** general descriptions”. Accordingly, in the claimed 42, descriptions that are narrow are reviewed first, and descriptions that are more

general are reviewed second, until a match is found. From *Ruben*, the Examiner has not shown a teaching other than reviewing in an **arbitrary** order. In contrast, claim 42 does so by reviewing increasingly more general descriptions. Accordingly, *Ruben* fails to teach this claim limitation.

Claim 45 is rejected in a similar manner, with the Examiner relying on the *same* passages in *Ruben* to teach the claim 45 recited, “successively reviewing increasingly more general descriptions of the management affiliation of the property until a property manager or property owner is identified”. Note, that claim 45 differs from claim 42 only in that claim 45 adds that a property owner may be identified as an alternative to the property manager. Accordingly, for the same reason *Ruben* falls short of teaching the claim 42 recited, “successively reviewing increasingly more general descriptions”, *Ruben* also falls short of teaching the claim 45 recited, “successively reviewing increasingly more general descriptions”. Accordingly, for similar reasons as claim 42, claim 45 is also not shown to be anticipated by *Ruben*. Applicants urge that the rejection under 35 USC § 102 has been overcome.

Since claims 44-46 depend from claims 42, the same distinctions between claims 44-46 and the claimed invention in claim 42 apply to these claims. Additionally, claims 44-46 claim other additional combinations of features not suggested by the references, either alone or in combination. For example, claim 44 includes the limitation “the service requestor is a tenant of the property associated with the service request, the tenant having access to the property management system”. Consequently, it is respectfully urged that the rejection of claims 44-46 have been overcome for these additional reasons.

Since claim 48 depends from claim 47, the same distinctions between claim 48 and the claimed invention in claim 47 apply to this claim. Additionally, claim 48 claims other additional combinations of features not suggested by the references, either alone or in combination. For example, claim 48 includes the limitation “the service requestor is a tenant of the property associated with the service request, the tenant having access to the property management system”. Consequently, it is respectfully urged that the rejection of claim 48 have been overcome for these additional reasons.

Accordingly, claims 42 and 44-48 are allowable over *Ruben*

III. 35 U.S.C. § 103 Obviousness

The Examiner has rejected claim 43 under 35 U.S.C. § 103(a) as being unpatentable over

Ruben in view of officially noticed prior art. Applicants respectfully traverse.

The examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 in U.S.C. §103. *In re Fritch*, 972 F.2d. 1260, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusions of obviousness. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (U.S. 2007) (citing *In re Khan*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Additionally, the prior art reference (or references, when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

An Examiner's use of Official Notice unsupported by documentary evidence should only be taken when the facts so noticed are “capable of such instant and unquestionable demonstration as to defy dispute.” See *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970) (citations omitted). Moreover, if the Examiner's assertion of Official Notice is adequately traversed, the Examiner must provide documentary evidence in the next Office Action to maintain the rejection. Manual of Patent Examining Procedure § 2144.03(C), Rev. 6, Sept. 2007(“MPEP”).

Applicants urge, that for the reasons stated above with respect to claim 42, *Ruben* fails to satisfy 35 U.S.C. § 103 definition of prior art (See Declaration dated October 13, 2006). This reason alone is sufficient to allow claim 43. Applicants will show still further reasons to allow claim 43.

Initially, Applicants urge that the officially noticed reference may not have been known at the time the invention was made, which applicants have attested to facts that indicate the invention was made prior to March 16, 2000. Applicants urge, that because the Examiner has not shown any reference to support the official notice, Applicants are unable to determine if the officially noticed prior art was known before the Applicants invention, or was known only after the Applicants' invention. Importantly, Applicants urge that the facts that the Examiner relies upon are not amenable to instant and unquestionable demonstration as to defy dispute. Accordingly, Applicants urge the Examiner to cite specific publications, patents and the like in order to satisfy MPEP § 2144.03(c) requirement to make clear all references upon which the Examiner relies.

Claim 43, like its parent claim 42, includes the limitation, “successively reviewing increasingly more general descriptions of the management affiliation until a property manager is identified”. Accordingly, for the same reasons as stated with respect to claim 42, even if *Ruben* were prior art (which Applicants urge that it is not) *Ruben* also fails to teach claim 43. In addition, the Examiner does not allege that officially noticed prior art teaches this feature. Instead, the Examiner alleges the officially noticed art:

Official notice is taken that such hierarchical tree traversal was known in the prior art at the time of the invention.
Office Action dated August 20, 2009 p. 5.

Accordingly, none of the Examiner relied-upon art teaches the limitation, “reviewing increasingly more general descriptions of the management affiliation until a property manager is identified”. Consequently, applicants have overcome the rejection under 35 USC § 103(a).

IV. Conclusion

It is respectfully urged that the subject application is patentable over *Ruben*, and Officially Noticed art for at least the reasons stated above, and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: October 16, 2009

Respectfully submitted,

/Robert C. Rolnik/

Robert C. Rolnik
Attorney
Reg. No. 37,995

The Rolnik Law Firm, P.C.
24 N. Main St.
Kingwood, TX 77339
(281) 973-5342
Attorney for Applicants